

REMARKS

This is intended as a full and complete response to the Restriction Requirement dated February 23, 2004, having a shortened statutory period for response set to expire on March 23, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-48 stand restricted under 35 U.S.C. § 121 as follows:

- I. Claims 1-18, drawn to a method of locating an item in a network of vending machines, classified in class 705, subclass 28.
- II. Claims 19-22 and 48, drawn to a vending machine, classified in class 700, subclass 231.
- III. Claims 23-34 and 45-47, drawn to a medium and system, classified in class 700, subclass 244.
- IV. Claims 35-44, drawn to a method of requesting a refund, classified in class 705, subclass 16.

Applicants provisionally elect Group I, with traverse.

The Examiner states that Inventions I and II are related as process and apparatus for its practice. The Examiner states that "the apparatus can be used to practice a materially different invention—a vending machine with a network interface." Respectfully, Applicants traverse the rejection and submit that this characterization is an improper application of restriction practice. Characterizing inventions as related as process and apparatus for its practice requires a showing that either (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. M.P.E.P. § 806.05(e). The Examiner's submission that "the apparatus can be used to practice a materially different invention" (emphasis added) does not conform to either of the showings required for one-way distinctiveness. Assuming that the Examiner intended to suggest that the apparatus can be used to practice a materially different process, the Examiner's basis for restriction is still insufficient in that the purported materially different process, i.e., "a vending machine with a network interface", is not a process, but rather an apparatus. In any case, the claims are not distinguishable on the

Page 10

C:\NrpPortB\NManage\JCHAI\RES\259877_1.DOC

basis of a network interface, as the claims of both groups recite a vending machine having a network interface. It should be noted that the amendment to claim 1 (and claim 23) to recite a network interface of the vending machine merely makes explicit what was previously implicit since claim 1 already recited a network of vending machines and a network connection which would require some form of a network interface. Accordingly, Applicants submit that the restriction is improper and request that the same be withdrawn.

The Examiner further submits that Inventions I and III are related as process and apparatus for its practice. Applicants respectfully traverse the rejection. First, the Applicants point out that, in the grouping above, the Examiner properly characterizes claims 23-34 as a "medium", which is article of manufacture, not an apparatus. Accordingly a rejection characterizing claims 23-34 as apparatus is improper. Second, claim 1 (of Group I) and claim 19 (of Group II) are identical counterparts of two different statutory classes, i.e., process and article of manufacture. As such, these claims are not restrictable from one another. A finding to the contrary subverts basic tenets of the rules of examination and proliferates multiple patents having identical claims that are distinguished only by their statutory classes. Accordingly, Applicants submit that the restriction is improper and request that the same be withdrawn.

The Examiner further submits that Inventions I and IV are related as some combinations disclosed as usable together in a single combination. In this case, the Examiner states that "invention IV has separate utility such as a method of returning an article and receiving a refund". First, Applicants submit that it is unclear as to how invention IV is capable of "receiving a refund" as suggested by the Examiner. Claim 35 recites "receiving an electronic refund request" (emphasis added). This aspect is also claimed in Group I (see, e.g., claims 9 and 10). Second, the inventions of both Groups are capable of "returning an article" since both groups are directed to vending machines capable of dispensing vending machine items. Accordingly, Applicants submit that the restriction is improper and request that the same be withdrawn.

The Examiner further submits that Inventions III and II are related as combination and subcombination. In the instant case, the Examiner suggests that "the combination as claimed does not require the particulars of the subcombination as claimed because

the combination does not require a processor configured to receive purchase orders." Respectfully, this is incorrect. The preamble of claim 23 recites: "A signal bearing medium, comprising a program which, when executed by a processor, performs an operation, comprising...receiving a purchase order..." (Emphasis added.) Accordingly, Applicants submit that the restriction is improper and request that the same be withdrawn.

The Examiner further submits that Inventions III and V are related as process and apparatus for practice. Applicants respectfully traverse the restriction. Again, claims 23-34 of Group III are directed to an article of manufacture, not an apparatus. Accordingly, Applicants submit that the restriction is improper and request that the same be withdrawn.

The Examiner further submits that this application contains claims directed to the following patentably distinct species of the claimed invention:

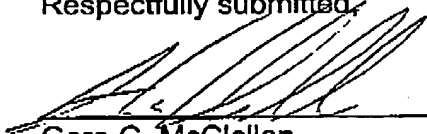
Species A: Represented by Figure 1; and

Species B: Represented by Figure 2.

Applicants elect Species A, with traverse. Applicants respectfully submit that the Examiner errs in suggesting that "[c]urrently, no claims are generic." Claim 1, for example, is generic, where claim 5 is directed to Species A and claims 6 and 18 are directed to Species B. Accordingly, a listing of all claims readable on the elected "species" is as follows: 1-5, 7-16, 18-27, 29-32, 34-37, and 39-48.

Having addressed all issues set out in the Restriction Requirement, Applicants respectfully request reconsideration of the claims.

Respectfully submitted,



Gero G. McClellan
Registration No. 44,227
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Agent for Applicant(s)